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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/480,011	01/10/2000	DEAN F. JERDING	A-5243	3800

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SCIENTIFIC-ATLANTA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
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EXAMINER

SHELEHEDA, JAMES R

ART UNIT	PAPER NUMBER
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2614

6

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/480,011

Applicant(s)

JERDING ET AL.

Examiner

James Sheleheda

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, 5-9, 11, 13, 16, 18, 20, 21 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Matthews, III (Matthews) (5,874,985).

As to claim 1, Matthews discloses a method for providing customizable multimedia messages over a television system to a communications terminal for presentation to a user (Fig. 1; column 1, lines 9-12), comprising:

creating a message configuration (wherein message formats have been created and stored in memory, 68; column 5, lines 60-67);

creating a message request (column 5, lines 44-48 and column 6, lines 12-14) for presenting message content to a user according to the message configuration (column 6, lines 14-21), wherein the message request includes the message content (the message of text, audio or video; column 6, lines 14-25), and a message configuration expression (message format; column 6, lines 14-18); and

sending the request to the communications terminal over the television system
(column 6, lines 30-37).

As to claim 3, Matthews discloses wherein the step of creating the request includes a step of including a message configuration expression that comprises a location reference to the message configuration (identifying the message format in memory the set top is to retrieve; column 5, lines 60-67 and column 6, lines 44-47).

As to claim 5, Matthews discloses delivering the message configuration to the communications terminal prior to the step of sending the request (Fig. 2; column 5, lines 60-67 and column 6, lines 44-47).

As to claim 6, Matthews discloses wherein the step of creating the request includes creating textual content as at least a portion of the message content (column 6, lines 21-25).

As to claim 7, Matthews discloses wherein the step of creating the request includes creating audio content as at least a portion of the message content (column 6, lines 21-25).

As to claim 8, Matthews discloses wherein the step of creating the request includes graphical content as at least a portion of the message content (column 6, lines 1-5 and lines 21-25).

As to claim 9, Matthews discloses wherein the step of creating the request includes message creating content consisting of a ticker tape (scrolling text; Fig. 4B; column 5, lines 30-35).

As to claim 11, Matthews discloses wherein the step of creating the message configuration includes providing a relative positioning of the message content on a display device (column 6, lines 18-21).

As to claim 13, Matthews discloses a method for receiving customizable multimedia messages over a television system at a communications terminal for presentation to a user (column 1, lines 9-12), comprising:

receiving a request at a communication terminal for presenting message content to a user according to a message configuration (column 6, lines 44-47), wherein the request includes the message content (the message of text, audio or video; column 6, lines 14-25) and a message configuration expression (message format; column 6, lines 14-18); and

presenting the message content to a user according to the message configuration by the communications terminal (column 6, lines 48-53).

As to claim 16, Matthews discloses wherein the step of presenting the message content includes presenting message content consisting of ticker tape (scrolling text; Fig. 4B; column 5, lines 30-35 and column 6, lines 61-65).

As to claim 18, Matthews discloses wherein the step of presenting the message content includes presenting the message content at a preselected position on a display device (column 6, lines 18-21 and column 6, lines 48-53).

As to claim 20, Matthews discloses a system for providing customizable messages over a television system to a communications terminal for presentation to a user (Fig. 1; column 1, lines 9-12), comprising:

a multimedia messaging server (Fig. 1; service and application server 202a) that receives (based on decisions of an operator; column 2, lines 67-65, column 3, lines 1-5 and column 7, lines 35-39) a message configuration (column 6, lines 14-21) and associated message content (column 6, lines 21-25) for presentation to a user according to the message configuration (column 6, lines 48-53) and generates a request including the message content and a message configuration expression (column 6, lines 12-18) for delivery over a television system to a communications terminal associated with the user (column 6, lines 30-37); and

a multimedia messaging client (Fig. 1; controller 20) that receives the request (column 6, lines 44-47) and associates the message content and the message

configuration for presentation of the message content according to the message configuration (column 6, lines 44-53).

As to claim 21, Matthews discloses wherein the message configuration expression comprises a location reference (identifying the message format in memory the set top is to retrieve; column 5, lines 60-67 and column 6, lines 44-47) that is utilized by the multimedia messaging client in retrieving the message configuration for use in presenting the message content by the communications terminal (column 6, lines 44-46).

As to claim 24, Matthews discloses wherein the multimedia messaging client (Fig. 2; controller 20) includes a client application (graphics subsystem, 72) and a configuration manager (CPU, 66), wherein the configuration manager provides the client application (column 6, lines 44-46 and column 4, lines 48-52) with the message configuration associated with the message content (column 5, lines 60-67 and column 6, lines 1-5).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews as applied to claim 1 above, and further in view of LaJoie et al. (LaJoie) (5,850,218).

As to claim 10, while Matthews discloses the creation of a message configuration for the presentation of the message content, he fails to specifically disclose wherein the message configuration includes providing a force interface device on command.

In an analogous art, LaJoie discloses a full service cable system (Fig. 1) incorporating message transmission over the cable network (column 33, lines 31-36) wherein the message is configured to include a command to force a set top terminal and television to turn on (column 33, lines 47-50) for the advantage of alerting subscribers to important information even when they are not actively watching their televisions (column 33, lines 50-54).

Consequently, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Matthew's system to include wherein the message configuration includes providing a force interface device on command, as taught by LaJoie, for the advantage of alerting subscribers to important information when they are not actively watching television.

As to claim 17, while Matthews discloses presenting the message content, he fails to include forcing an interface device on for presentation of the message content.

In an analogous art, LaJoie discloses a full service cable system (Fig. 1) incorporating message transmission over the cable network (column 33, lines 31-36)

wherein the message is configured to include a command to force a set top terminal and television to turn on to display a message (column 33, lines 47-50) for the advantage of alerting subscribers to important information even when they are not actively watching their televisions (column 33, lines 50-54).

Consequently, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Matthew's system to include forcing an interface device on for presentation of the message content, as taught by Lajoie, for the advantage of alerting subscribers to important information when they are not actively watching television.

5. Claims 12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews as applied to claims 1 and 13 above, and further in view of Hashimoto et al. (Hashimoto) (5,931,905).

As to claim 12, while Matthews discloses the creation of a message configuration for the presentation of the message content, he fails to specifically disclose wherein the message configuration includes providing an originator identifier.

In an analogous art, Hashimoto discloses a TV mail system (Fig. 1) incorporating message transmission over the cable network (column 1, lines 58-62) wherein the messages are configured to include an identification of the sender of the message (Fig. 7; column 5, lines 64-65). This allows subscribers to easily identify from whom they are receiving electronic messages (Figs. 4 and 10B; column 11, lines 14-21 and column 12, lines 14-17).

Consequently, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Matthew's system to include wherein the message configuration includes providing an originator identifier, as taught by Hashimoto, for the advantage allowing subscribers to easily identify from whom they are receiving electronic messages by including an originator identifier in the existing message format.

As to claim 19, while Matthews discloses the step of presenting the message content, he fails to specifically disclose displaying a representation of an originator of the request.

In an analogous art, Hashimoto discloses a TV mail system (Fig. 1) incorporating message transmission over the cable network (column 1, lines 58-62) wherein received messages are configured to display an identification of the sender of the message (Fig. 7; column 5, lines 64-65). This allows subscribers to easily identify from whom they are receiving electronic messages (Figs. 4 and 10B; column 11, lines 14-21 and column 12, lines 14-17).

Consequently, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Matthew's system to include displaying a representation of an originator of the request, as taught by Hashimoto, for the advantage allowing subscribers to easily identify from whom they are receiving electronic messages by including an originator identifier in the existing message format.

6. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews as applied to claims 1 and 13 above, and further in view of Tanaka (US2003/0115600).

As to claim 4, while Matthews discloses the delivering of the message configuration to the communications terminal, he fails to specifically disclose wherein the message configuration is delivered from a location associated with the location reference.

In an analogous art, Tanaka discloses a television broadcast system (Fig. 1) wherein detailed information relating to a program or other data (paragraph 142, lines 1-8) is retrieved from a server based upon address information transmitted to the receiver (paragraph 9 and paragraph 10, lines 4-10), for the advantage of allowing the use of a receiver without an large storage means (paragraph 8 and paragraph 11).

Consequently, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Matthew's system to include wherein the message configuration is delivered from a location associated with the location reference, as taught by Tanaka, for the advantage of allowing the use of a receiver without an large storage means in the current message transmission system.

As to claim 14, while Matthews discloses retrieving the message configuration utilizing the message configuration expression, wherein the message configuration expression comprises a location reference (identifying the message format in memory

the set top is to retrieve; column 5, lines 60-67 and column 6, lines 44-47), he fails to disclose retrieving the message configuration from a remote location.

In an analogous art, Tanaka discloses a television broadcast system (Fig. 1) wherein detailed information relating to a program or other data (paragraph 142, lines 1-8) is retrieved from a remote server based upon address information transmitted to the receiver (paragraph 9 and paragraph 10, lines 4-10), for the advantage of allowing the use of a receiver without an large storage means (paragraph 8 and paragraph 11).

Consequently, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Matthew's system to include retrieving the message configuration from a remote location, as taught by Tanaka, for the advantage of allowing the use of a receiver without an large storage means in the current message transmission system.

7. Claims 2, 15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews as applied to claims 1, 13 and 20 above, and further in view of Jennings (5,781,186).

As to claim 2, while Matthews discloses wherein the step of creating the request includes a step of including a message configuration expression, he fails to specifically disclose wherein the message configuration expression comprises the message configuration.

In an analogous art, Jennings discloses a multimedia messaging system (Fig. 1; column 1, lines 7-8) wherein a created message contains components of both the

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message (column 1, lines 63-67) and presentation components (which determine how the message is displayed; column 2, lines 1-4) for the advantage of enabling a message to specify exactly how it should be presented without the need for any additional programming or equipment (column 2, lines 25-40).

Consequently, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Matthew's system to include wherein the message configuration expression comprises the message configuration, as taught by Jennings, for the advantage of enabling a message to specify exactly how it should be presented without the need for any additional programming or equipment to be incorporated into the existing messaging system.

As to claim 15, while Matthews discloses wherein the step of presenting the message content includes presenting the message content according to the message configuration expression, he fails to specifically disclose wherein the message configuration expression comprises the message configuration.

In an analogous art, Jennings discloses a multimedia messaging system (Fig. 1; column 1, lines 7-8) wherein the presentation of messages is determined by presentation components contained within the message itself (column 1, lines 63-67 and column 2, lines 1-4) for the advantage of enabling a message to specify exactly how it should be presented without the need for any additional programming or equipment (column 2, lines 25-40).

Consequently, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Matthew's system to include wherein the message configuration expression comprises the message configuration, as taught by Jennings, for the advantage of enabling a message to specify exactly how it should be presented without the need for any additional programming or equipment to be incorporated into the existing messaging system.

As to claim 22, while Matthews discloses a message configuration expression for use in presenting the message content by the communication terminal, he fails to specifically disclose wherein the message configuration expression comprises the message configuration.

In an analogous art, Jennings discloses a multimedia messaging system (Fig. 1; column 1, lines 7-8) wherein the presentation of messages is determined by presentation components contained within the message itself (column 1, lines 63-67 and column 2, lines 1-4) for the advantage of enabling a message to specify exactly how it should be presented without the need for any additional programming or equipment (column 2, lines 25-40).

Consequently, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Matthew's system to include wherein the message configuration expression comprises the message configuration, as taught by Jennings, for the advantage of enabling a message to specify exactly how it should be

presented without the need for any additional programming or equipment to be incorporated into the existing messaging system.

8. Claim 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews in view of Freeman (6,020,980) and Hendricks (5,559,549).

As to claim 25, Matthews discloses a system for delivery of multimedia messages, comprising: a multimedia messaging server (service and application servers, 202a) which generates a request (column 7, lines 35-39) that comprises the message content (the message of text, audio or video; column 6, lines 14-25 and column 7, lines 35-39) and a message configuration expression (message format; column 6, lines 14-18). While Matthews discloses wherein an operator (at central node, 12) controls the distribution of message content (column 7, lines 35-39), he fails to specifically disclose a database of predefined message configurations accessible by the messaging server and an application server that generates the message content and delivers the message content to the multimedia server.

In an analogous art, Freeman discloses a communication system (Fig. 1) wherein Fax Server (122) will receive facsimile messages and contact an associated database (Subscriber directory, 126) to determine the correct file configuration for a particular subscriber (column 8, lines 7-14 and lines 30-35) for the advantage of allowing subscribers to receive messages in any format they desire (column 3, lines 23-30).

Additionally, in an analogous art, Hendricks discloses a digital television distribution system (Fig. 1; column 2, lines 61-65) wherein an operations center (Fig. 1, 202; application server) will generate and transmit program information (including text messages; column 11, lines 27-34) to remote headends (multimedia servers; column 3, lines 32-44) which then configure the program information for transmission to subscriber terminals (column 3, lines 52-64) for the advantage of allowing the altering/updating of information transmitted throughout regions of the country (column 3, lines 38-44).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Matthew's system to include a database of predefined message configurations accessible by the messaging server, as taught by Freeman, for the advantage of allowing subscribers to receive messages in any format they desire by implementing the messaging system with a stored database of desired message formats.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Matthew and Freemans's system to include an application server that generates the message content and delivers the message content to the multimedia server, as taught by Hendricks, for the advantage of allowing a single server to control the altering/updating of information transmitted throughout different regions of the country by local headends (or multimedia servers).

As to claim 26, Matthews, Freeman and Hendricks disclose wherein the message configuration expression comprises a location reference (identifying the

message format in memory the set top is to retrieve; see Matthews at column 5, lines 60-67 and column 6, lines 44-47).

9. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews, Freeman and Hendricks as applied to claim 25 above, and further in view of Jennings.

As to claim 27, while Matthews, Freeman and Hendricks disclose a message configuration expression, they fail to specifically disclose wherein the message configuration expression comprises the message configuration.

In an analogous art, Jennings discloses a multimedia messaging system (Fig. 1; column 1, lines 7-8) wherein a created message contains components of both the message (column 1, lines 63-67) and presentation components (which determine how the message is displayed; column 2, lines 1-4) for the advantage of enabling a message to specify exactly how it should be presented without the need for any additional programming or equipment (column 2, lines 25-40).

Consequently, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Matthews, Freeman and Hendrick's system to include wherein the message configuration expression comprises the message configuration, as taught by Jennings, for the advantage of enabling a message to specify exactly how it should be presented without the need for any additional programming or equipment to be incorporated into the existing messaging system.

10. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews as applied to claim 20 above, and further in view of Freeman.

As to claim 23, while Matthews discloses the selection of a message configuration by the multimedia server, he fails to specifically disclose he fails to specifically disclose a database of message configurations accessible by the messaging server.

In an analogous art, Freeman discloses a communication system (Fig. 1) wherein Fax Server (122) will receive facsimile messages and contact an associated database (Subscriber directory, 126) to determine the correct file configuration for a particular subscriber (column 8, lines 7-14 and lines 30-35) for the advantage of allowing subscribers to receive messages in any format they desire (column 3, lines 23-30).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Matthew's system to include a database of predefined message configurations accessible by the messaging server, as taught by Freeman, for the advantage of allowing subscribers to receive messages in any format they desire by implementing the messaging system with a stored database of desired message formats.

Conclusion

11. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in

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such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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P.O. Box 1450
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Typed or printed name of person signing this certificate:

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Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703)_____ - _____ on _____.
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Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

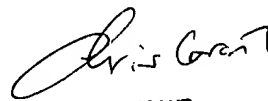
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (703) 305-8722. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the primary examiner, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Sheleheda
Patent Examiner
Art Unit 2614

JS



CHRIS GRANT
PRIMARY EXAMINER